



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. Box 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Paper No. 21

LERNER, DAVID, LITTENBERG,
KRUMHOLZ & MENTLIK
600 SOUTH AVENUE WEST
WESTFIELD NJ 07090

COPY MAILED

NOV 04 2004

OFFICE OF PETITIONS

In re Application of: :
Finn and Sherman : DECISION ON PETITION
Application No. 08/988,331 : UNDER 37 CFR 1.183
Filed: December 11, 1997 :
Atty. Docket No. 1968-REISSUE :
:

This is a decision on the petition under 37 CFR 1.47(a), filed on July 14, 2003, which is being treated as a petition under 37 CFR 1.183 seeking waiver of the rule (presumably § 1.172) that requires that the inventor to sign any supplemental declaration in a broadening reissue application.

The petition is granted.

BACKGROUND

On December 11, 1997, the present application was filed as an application for reissue of U.S. Patent No. 5,454,511, by inventors Charles A. Finn and Scott Sherman, who executed an original reissue declaration.

During the prosecution of the present application, the Office required a supplemental declaration directed to errors in the original patent which were corrected in the present reissue application after the signing of the original reissue declaration.

According to the declarations supplied by the Scott S. Servilla and Geoffrey Trigger, together with the present petition, inventor Scott Sherman could not be located to sign the supplemental declaration after diligent effort to find him.

DECISION

35 U.S.C. 251, which is directed to reissue, does not address the signature requirements of a declaration in reissue.

37 CFR 1.172 requires that a reissue declaration be made (and signed) by the inventors, except as otherwise provided (§§ 1.42, 1.43, 1.47), where the scope of the claims of the original patent is being enlarged. 37 CFR 1.175(b)(1), requires that:

"For any error corrected, which is not covered by the oath or declaration submitted under paragraph (a) of this section, applicant must submit a supplemental oath or declaration stating that every such error arose without any deceptive intention on the part of the applicant."

37 CFR 1.175(b)(1), taken in conjunction with 37 CFR 1.172, requires a supplemental declaration to be signed by the inventor. This is because all oaths or declarations necessary to fulfill the rule requirements in a reissue application are taken together collectively as a single oath or declaration. Thus, each oath and/or declaration must bear the appropriate signature of the inventor. See *In re Hayes*, 53 USPQ2d 1222 (Comm'r Pat. 1999).

37 CFR 1.183 permits, in an extraordinary situation, waiver of a rule which is not a requirement of the statute, where justice requires such waiver, and applicant has requested a waiver of the requirement that the 37 CFR 1.175(b)(1) supplemental declaration be signed by an inventor.

The instant petition is accompanied by an appropriate showing that inventor Sherman could not be located after diligent effort. Accordingly, the supplemental declaration of July 14, 2003, signed by inventor Charles A. Finn will be accepted as though it was signed by joint inventors Finn and Sherman as required by 37 CFR 1.175(b)(1) taken in conjunction with 37 CFR 1.172.

The \$130.00 petition fee will be charged to Deposit Account No. 12-1095, as authorized.

CONCLUSION

The present petition to waive 37 CFR § 1.172 is granted.

The application is being forwarded to Technology Center 3700 for further prosecution.

Please direct any questions related to this decision to Christina Tartera Donnell, Petitions Attorney, at (571) 272-3211.



Kenneth M. Schor
Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration